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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,327	11/08/2001	Michael Alan Reeve	PA-0071	3254

7590 07/26/2005

Amersham Biosciences
800 Centennial Avenue
Piscataway, NJ 08855

EXAMINER

DO, PENSEE T

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,327

Applicant(s)

REEVE, MICHAEL ALAN

Examiner

Pensee T. Do

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment Entry & Claim Status

The amendment filed on May 12, 2005 has been acknowledged and entered.

Claims 1-16 are pending. Claims 1-3 are being examined. Claims 4-16 are non-elected and withdrawn from further consideration.

Maintained Rejections

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Owen et al. (US 4,795,698).

Owen teaches magnetic-polymer particles wherein the magnetic particles are magnetite (Fe₃O₄). Such magnetic polymer particles are coated with avidin. (see col. 3, lines 24-32; claim 10).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ekenberg (US 5,693,784).

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Ekenberg teaches an agglomeration of colloidal magnetic particles coated with streptavidin. The magnetic particles are metal oxides (Fe_3O_4). (see col. 4, lines 61-65; col. 5, lines 60-65; claim 23).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Rao (US 5,660,990).

Rao teaches magnetic particles coated with avidin or streptavidin. Magnetic particles behave as colloids and are prepared according to the methods of Owen (US 4,795,698). These particles are Fe_3O_4 . (see col. 8, lines 45-63; col. 9, lines 1-4; col. 12, lines 16-26).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Terstappen (US 6,228,624).

Terstappen teaches using magnetic particles prepared by methods in US patent 4,795,698 by Owen wherein Owen teaches preparation of magnetic particles by using solution containing Fe(II) and Fe(III) and a polymer treated with a strong base in order to precipitate magnetic iron oxides such as magnetite (Fe_3O_4) in a form which is intimately combined with the polymer. Such magnetic particles are coated with avidin or streptavidin. (see col. 2, lines 41-43; col. 3, lines 50-52).

Response to Arguments

Applicant's arguments filed May 12, 2005 have been fully considered but they are not persuasive.

Applicants have amended the claims to recite "a composition consisting essentially of..." and argued that the references cited in the previous office action are

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irrelevant to the amended claims. The composition in the references cited by the examiner contains an additional polymer coating whereas the present invention does not.

The language "consisting essentially of" fails to exclude all the extraneous materials in a composition.

MPEP 2111.03 [R-2] states that "For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of" for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also > AK Steel Corp. v. Sollac, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003).

The additional polymer coating fails to affect the basic and novel characteristics of the present invention because such a coating is well known in the art for providing functional groups to immobilize the affinity ligand such as a streptavidin or avidin. Therefore, the references applied in the previous office action are still relevant to the claims as presented.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
July 23, 2005


LONG V. LE
SUPERVISORY PATENT EXAMINER
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07/24/05